

REMARKS

The present amendment is prepared in accordance with the requirements of 37 C.F.R. § 1.121. A complete listing of all the claims in the application is shown above showing the status of each claim. For current amendments, inserted material is underlined and deleted material has a line there-through.

The present amendment is being filed concurrently with a Request for Continued Examination under 37 CFR 1.114 of the subject patent application.

Claims 1, 14, and 20 have been amended, and claims 48-72 have been added. Support for the amendments and new claims can be found in the specification.

No new matter has been added.

In the foregoing Preliminary Amendment, the claims of the present application have been amended and new claims added to clarify that which applicants regard as the invention, whereby the microbiological interception enhancing agent resides on the fibers, active agents or both, and resides within and throughout the entire thickness of the present integrated paper.

Applicants continue to disagree with the Examiner's rejections and submit that the claims are patentable over the cited prior art of record. In the recent Advisory Action, the Examiner states that "applicant argues that the secondary reference teaches a coating, not precipitation, but as discussed in the previous office action, coating is a preferred embodiment and they teach other processes that involves the precipitation of the agent on an article. This teaching would indicated to one of ordinary skill in the art, that the fibers can be loaded with the antimicrobial precipitate at the wet end of the papermaking operation. Note that it would not make any sense to precipitate the components onto the formed web for the following reasons: (1) the uniformity of

the coating would be difficult to control; (2) the antimicrobial properties would only be affected at one surface of the web or has to be double precipitation to cover the other surface of the web; (3) if one wanted to limit the anti-microbial properties just to the surface of the paper, one of ordinary skill in the art would definitively coat the web instead of precipitating the components on the surface, since coating would be more economical and much more easy to control i.e., the uniformity of the coating. Therefore, as it can be seen, if the antimicrobial agent were to be precipitated, it would have to be onto the fibers, not the formed web. One of ordinary skill in the art would realize that doing it in such a way the antimicrobial properties would be affected throughout the web, not only on its surface/surfaces."

Again, Giglia does not disclose or suggest that a microbial interception enhancing agent resides within and throughout an integrated paper (i.e. throughout the entire thickness thereof), as is claimed. The Examiner recognizes the same.

Neither of the Sawan references ((US Patent No. 5,681,468 hereinafter "Sawan '468") or (US Patent No. 5,817,325 hereinafter "Sawan '325") overcome this deficiency of Giglia.

Sawan '468 discloses a liquid dispenser that has a filter coated with a metallic material on its surface and within its pores. (Abstract and col. 2, ll. 11-15 and 54-67.) The filter is coated with a carbonyl compound or with an activator, followed by contact with a metal salt and an amine-containing compound solution. (Col. 4, ll. 7-24, col. 9, ll. 10-16 and col. 10, ll. 15-27 and Example 12 at col. 15, ll. 13-34.) Sawan '468 discloses that the metal salt and the amine-containing compound are in the same solution, and the carbonyl-coated filter is contacted with this solution. According to Sawan '468, the carbonyl compound reduces the metal ion to metal so as to deposit the metal on the filter surface and within pores of the filter. (Col. 9, ll. 10-52.)

Sawan '468 further discloses that its metal coating preferably has a uniform metal coating thickness on the surface and within the pores of the filter. (Col. 9, ll. 44-52.)

Similarly, Sawan '325 is limited to coatings or layers and discloses an antimicrobial material of an organic material which forms a matrix and a biocidal material intercalated in the matrix to form a contact-killing coating on a substrate or to make freestanding antimicrobial films (not attached to a substrate). (Col. 4, ll. 9-32.) The compositions of Sawan '325 are applied to various substrates to form antimicrobial coatings or layers on the substrates, whereby the solution, dispersion or suspension of Sawan '325 is applied to a substrate to form the matrix. (Col. 4, ll. 33-41 and col. 8, ll. 41-43.) The solution, dispersion or suspension is applied to the substrate by any suitable means for applying a liquid coating, and then dried to form the matrix. (Col. 4, ll. 56-67.) The matrix is then contacted with the biocidal material to deposit the biocidal material into the matrix. (Col. 5, ll. 3-7 and col. 9, ll. 44-46.) Alternatively, the organic material and the biocidal material may be combined in solution and then applied to the substrate to form the matrix. (Col. 5, ll. 8-20 and col. 9, ll. 44-46.) As another embodiment, a freestanding antimicrobial film may be formed using the antimicrobial material of Sawan '325. (Col. 5, ll. 37-59 and col. 8, ll. 41-43.)

In the Advisory Action the Examiner states that it would not make any sense to precipitate the components onto the formed web for a number of reasons. However, applicants submit that this is exactly what the Sawan references teach and disclose. The Examiner then discusses the benefits of precipitating an anti-microbial agent onto fibers and not onto the formed web, and states the one of ordinary skill in the art would realize that doing it in such a way the antimicrobial properties would be affected throughout the web, not only on its surface/surfaces.

Yet, applicants submit that the only evidence of record to support such a proposition is applicant's invention itself, which of course is an improper hindsight reconstruction.

Applicants submit that the examiner has pointed to individual components of applicants claimed invention rather than taking applicants' claims as a whole. An invention "composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.* 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, (2007). The record must show that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." *Id.* at 1741. Here the record contains no such finding.

It is also submitted that approaches to obviousness determinations which focus merely on identifying and tabulating "missing elements" in hindsight retrospect "imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge," and, "fall victim to the insidious effect of hindsight syndrome where that which only the inventor taught is used against its teacher." *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1553 [220 USPQ 303] (Fed. Cir. 1983). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d at 1075, 5 U.S.P.Q.2d at 1600. For the reasons as discussed above, applicants submit that the record supports a conclusion of nonobviousness. It is submitted that any contrary conclusion would be based on hindsight.

Further, there is nothing in the record to show or indicate that a skilled artisan would have had a "reasonable expectation of success" in deriving the claimed invention in light of the teachings of the prior art. See, *In re Kubin* (Fed. Cir. April 3, 2009), citing, *In re O'Farrell*, 853 F.2d 894, 904 (Fed. Cir. 1988). As such, the claimed invention was not reasonably expected in

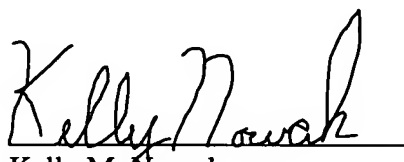
light of the prior art, and therefore, was not "obvious to try." *See Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008). Again, the record supports a finding of non-obviousness.

Applicant submits that the structures of the present invention are different from that of the cited references, such that, the cited references, either alone or in any proper combination thereof do not anticipate nor render obvious the present invention.

For the reasons as discussed above, applicant submits that the present invention is not obviousness over the cited references of record since none of these references, alone or in combination, disclose, contemplate or suggest a microbiological interception enhancing agent residing on a portion of selected fibers, active agents or both as is currently claimed. It is only applicant's disclosure that teaches a microbiological interception enhancing agent on a portion of selected selected fibers and/or active agents, which of course, is improper as a hindsight reconstruction of applicant's invention.

It is respectfully submitted that the application is in a condition where allowance of the case is proper. Issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,


Kelly M. Nowak
Reg. No. 47,898

DeLIO & PETERSON, LLC
121 Whitney Avenue
New Haven, CT 06510-1241
(203) 787-0595